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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/615,721	07/08/2003	Howard W. Lutnick	03-1082	9421
63710                      7590                      12/24/2009 INNOVATION DIVISION CANTOR FITZGERALD, L.P. 110 EAST 59TH STREET (6TH FLOOR) NEW YORK, NY 10022				
EXAMINER JOHNSON, GREGORY L.				
ART UNIT		PAPER NUMBER		
3691				
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12/24/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/615,721

**Applicant(s)**

LUTNICK ET AL.

**Examiner**

GREGORY JOHNSON

**Art Unit**

3691

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 23 September 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 65-74 and 88-97 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 65-74 and 88-97 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB-06)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. The following is a final Office Action on the merits. The Amendments/Remarks received on September 23, 2009, have been entered. Claims 52-64 & 75-87 have been cancelled. Claims 65 & 88 are amended. Claims 66-74 & 89-97 are as previously presented. **Claims 65-74 & 88-97** are pending.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. **Claims 65-74 & 88-97** are rejected under 35 U.S.C. 102(b) as being anticipated by Kossovsky et al. (U.S. 2002/0004775).

**As per claim 65**, Kossovsky et al. teaches a method comprising:

capturing market data for a plurality of companies via a processor (See paragraphs 35-37 & 93, which discusses downloading financial market data), each of the plurality of companies identified from a group of companies based at least on intellectual property asset data for the group of companies, in which the processor performs in accordance with a program that is stored in a memory (See paragraphs 10, 35-37 & 109, which discusses using information about an intellectual property asset and data from publicly traded companies; and, furthermore, identifying the sector and narrowly focused market segments);

calculating via the processor an intellectual property index based at least on the market data for the plurality of companies (See paragraph 11 & 35-37, which discusses an index of market value of intellectual property belonging to a technology classification);

receiving, from a remote device, a plurality of orders for at least one derivative financial instrument that comprises at least one term associated with the intellectual property index, in which the remote device and the processor are in communication over a network (See paragraph 35-37 & 199, which discusses receiving traditional purchase orders for intellectual property assets); and

executing via the processor a trade for the at least one derivative financial instrument (See paragraphs 35-37, 128 & 136, which discusses options traded between other sellers and buyers/parties).

**As per claim 66**, Kossovsky et al. teaches wherein the group of companies comprises a plurality of companies in substantially the same industry (See paragraphs 45 & 85, which discusses assigning a sector; and, furthermore, defining a set of major commercial sectors).

**As per claim 67**, Kossovsky et al. teaches wherein the group of companies comprises a plurality of companies having a particular market capitalization (See paragraphs 60 & 87, which discusses selecting a company based on capitalization; and, furthermore, providing an example of a defined market capitalization).

**As per claim 68**, Kossovsky et al. teaches wherein the plurality of companies are identified based at least on a value associated with an intellectual property asset

portfolio for each of the plurality of companies (See claim 4, which discusses intellectual property valuation in terms of enterprise value of companies in the same technology classification as the intellectual property asset).

**As per claim 69**, Kossovsky et al. teaches wherein each of the intellectual property asset portfolios comprises at least one patent (See paragraph 44, which discusses how the portfolio includes at least one patent) and wherein the value associated with each portfolio is based at least on a number of citations to the at least one patent by a national patent office (See figure 18A, which illustrate published description, proven applications, potential applications, etc.; it is inherent that these application will include relevant citations).

**As per claim 70**, Kossovsky et al. teaches wherein each of the intellectual property asset portfolios comprises at least one patent (See paragraph 44, which discusses how the portfolio includes at least one patent) and wherein the value associated with each portfolio is based at least on a number of patents issued to the company by a national patent office (See figure 18A & paragraph 132, which illustrates and discusses country issued, if the application is pending, etc.; and, furthermore, call options in the context of issued patents).

**As per claim 71**, Kossovsky et al. teaches wherein each of the intellectual property asset portfolios comprises at least one patent (See paragraph 44, which discusses how the portfolio includes at least one patent) and wherein the value associated with each portfolio is based at least on the age of the at least one patent (See paragraphs 94, which discusses remaining patent term).

**As per claim 72**, Kossovsky et al. teaches wherein each of the intellectual property asset portfolio comprises at least one patent (See paragraph 44, which discusses how the portfolio includes at least one patent) and wherein the value associated with each portfolio is based at least on litigation results associated with the at least one patent (See figure 18B, which illustrates litigation history and pending litigation).

**As per claim 73**, Kossovsky et al. teaches wherein the value associated with an intellectual property asset portfolio is determined based on at least one of licensing contracts and revenues (See figure 18D & paragraph 10, which illustrates and discusses details of a licensing offer, including a specified licensing term).

**As per claim 74**, Kossovsky et al. teaches wherein the market data comprises a stock price for each of the plurality of companies (See paragraph 80, which discusses the price of an underlying stock).

**As per claim 88**, Kossovsky et al. teaches a system comprising at least one processor having software associated therewith that when executed instructs the processor to perform a method comprising (See figure 1, 2A, & 2B, which illustrates a computer system and hardware/software structures):

capturing market data for a plurality of companies (See paragraph 93, which discusses downloading financial market data), each of the plurality of companies identified from a group of companies based at least on intellectual property asset data for the group of companies (See paragraphs 10 & 109, which discusses using information about an intellectual property asset and data from publicly traded

companies; and, furthermore, identifying the sector and narrowly focused market segments);

calculating an intellectual property index based at least on the market data for the plurality of companies (See paragraph 11, which discusses an index of market value of intellectual property belonging to a technology classification);

receiving a plurality of order for at least one derivative financial instrument that comprises at least one term associated with the intellectual property index (See paragraph 199, which discusses receiving traditional purchase orders for intellectual property assets); and

executing a trade for the at least one derivative financial instrument (See paragraphs 128 & 136, which discusses options traded between other sellers and buyers/parties).

**Claims 89-97** recite equivalent limitations to claims 66-74, respectively, and are therefore rejected using the same art and rationale as set forth above.

#### ***Response to Arguments***

4. Applicant's arguments filed September 23, 2009, have been fully considered but they are not persuasive.

In the remarks, the Applicant argues in substance (pgs. 7-9):

The Examiner provides no explanation as to why he disagrees with Applicants' arguments in the Appeal Brief. He simply states that he disagrees with Applicants' assertions ... and then he repeats, verbatim, his previously stated arguments from the Final Office Action of May 22, 2008 ("Final Action").

In Response: The Examiner's stated response/arguments recited in the Final Office Action of May 22, 2008 to Applicant's arguments continue to be valid and therefore, remain on record.

Applicant's arguments include:

**(a)**, pg. 7, the item underlying the Kossovsky options is an actual patent, not the IP index

**(b)**, pgs. 7-8, Kossovsky does not teach wherein the plurality of companies are identified based at least on a value associated with an intellectual property asset portfolio for each of the plurality of companies

**(c)**, pg. 8, Kossovsky does not teach a number of citations to the at least one patent;

**(d)**, pg. 9, Kossovsky does not teach a number of patents issued to the company by a national patent office; and

**(e)**, pg. 9 Kossovsky does not teach the age of at least one patent.

In response to **(a) & (b)**:

The Examiner respectfully disagrees with applicant's assertion. First, Examiner cited applicant to paragraph 11 when referring to an IP index. This disclosure teaches an index of market value of intellectual property that is useful for generating a relative measure of financial risk. Second, this disclosure indicates that Kossovsky teaches and suggests an intellectual property index based on market data from publicly traded companies. Furthermore, Kossovsky discloses trading options, or contractual right to

purchase a technology from a owner at a predetermined price before a set expiration (See paragraph 130). Under broadest reasonable interpretation, these two disclosures teach and suggest trading at least one derivative financial instrument (i.e. option) that comprises at least one term associated with an intellectual property index (i.e. option to purchase patented technology listed within the intellectual property index). Finally, Kossovsky discloses how buyers and sellers utilize the intellectual property index to asses the risk of an asset they are buying or licensing (See paragraph 106). It is clear from this disclosure that Kossovsky suggests assessing an asset utilizing a intellectual property index before executing a respective trade involving the market value of the asset belonging to the technology classification of the specified index. Therefore, Kossovsky anticipates claim 65 and the similar features recited in claim 88.

In response to (c): See figure 5B, which illustrates citations.

In response to (d): See figure 5A & ¶0043, which discusses and illustrates a seller's stored IP listing in an exchange database; seller's patent inventory.

In response to (e): See figure 8, ¶0010 & ¶0095, which discusses the remaining term of a central patent, patent issue date and number of years until expiration of the patent.

***Conclusion***

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to GREGORY JOHNSON whose telephone number is (571)272-2025. The examiner can normally be reached on Monday - Friday, 8:30AM - 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ALEXANDER KALINOWSKI can be reached on (571) 272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

GREGORY JOHNSON  
Examiner, Art Unit 3691

/Hani M. Kazimi/  
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